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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,575	02/12/2002	Lewis Lee Knox		5964
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EXAMINER

ALLEN, ANDRE J

ART UNIT

PAPER NUMBER

2855

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,575

Applicant(s)

KNOX ET AL.

Examiner

Andre J. Allen

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "comprising," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1,2,5 and 6,7,8,9 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-8 and 10 of copending

Application No. 09753391. This is a provisional double patenting rejection

Art Unit: 2855

since the conflicting claims have not in fact been patented. In this case the copending application 09753391 teaches all the features of the claimed invention for example;

- A continuous real time tire pressure monitoring and display system for a transport vehicle comprising:

-a) a piston mounted magnet in a cylinder mounted on the inside wall of each tire of said transport vehicle;

b) a permanent magnet mounted perpendicular to said piston mounted magnet and mounted inside each said tire of said transport vehicle;

-c) a transducer mounted on each rim of each said tire of said transport vehicle; and

d) an electronics module mounted in said transport vehicle and connected to each said transducer by at least one electrical conductor. (claim 6)

- said electronics module comprises a micro controller and a display. (claim 7)

- a) a sensor means mounted on each tire of said motor vehicle for measuring the pressure in a rotating tire and representing said information as a series of magnetic pulses;

b) a means of capturing the magnetic pulses by a transducer into a stream of digital pulses;

c) a means of converting said digital pulses into an air pressure value; and

- d) a means of displaying said air pressure value. (claim 8)

- a) a piston mounted magnet in a cylinder mounted on the inside wall of each tire of said motor vehicle; and
- b) a permanent magnet mounted perpendicular to said piston mounted magnet and mounted inside each said tire of said transport vehicle. (claim 6)
- said transducer is mounted on each rim of each said tire of said transport vehicle. (claim 10)
- said means of converting said digital pulses into an air pressure value comprises an electronics module mounted in said motor vehicle and is connected to each said transducer by at least one electrical conductor. (claim 10)
- a) mounting at least one magnet on the inside wall of each tire of said transport vehicle; (claims 10)
- b) mounting a sensor on the rim of each said tire of said transport vehicle; (claim 10)
- c) transducing the output of said sensor into electrical pulses; (claim 10)
- d) communicating said pulses to an electronics module through at least one electrical conductor (claim 10)
- e) computing tire pressure value as a function of said pulses; (claim 10)

Art Unit: 2855

f) displaying said tire pressure value for each said tire. (claim 10)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3,4 and 10 is provisionally rejected under the judicially created doctrine of double patenting over claims 6-10 of copending Application No. 09753391. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Copending application 09753391 teaches all the basic features of the claimed invention except electronics module mounted in a passenger compartment (claim 3), a cockpit (claim 4) and a microcontroller. However since claims 6-10 of copending application 09753391 teaches at least

“computing tire pressure value as a function of said pulses” and every other structure as claimed in the above patent application it would appear to be within the experimental skills of one in the ordinary skill in the art to provide a specific element such as a “micro-controller” to “compute tire pressure value as a function of said pulses” and provide places to mount the invention for example a passenger compartment or a cockpit. Therefore it would have been clearly obvious of one ordinary skilled in the art at the time the invention was made to provide specific places to mount this tire monitoring apparatus and use a micro-controller to compute pressure as a function of pulses for the purpose of optimizing the characteristics of a tire monitoring apparatus. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre J. Allen whose telephone number is 703-3081989. The examiner can normally be reached on mon-fri 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Fuller can be reached on 703-308-0079. The fax

Art Unit: 2855

phone numbers for the organization where this application or proceeding is assigned are 703-308-3432 for regular communications and 703-308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A.J.A
August 23, 2002


Benjamin R. Fuller
Supervisory Patent Examiner
Technology Center 2800